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EXAMINER

COOLEY, CHARLES E

ART UNIT PAPER NUMBER

1723

9

DATE MAILED: 01/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/707,430

Applicant(s)  
Cornay

Examiner  
Charles Cooley

Art Unit  
1723



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 3 Oct 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-12 is/are pending in the application.
- 4a) Of the above, claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 3-12 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 29 May 2000 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 20) ☐ Other:

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## OFFICE ACTION

1. This application remains assigned to Technology Center 1700, Art Unit 1723 and the following will apply for this application:

a. Please direct all written correspondence with the correct application serial number for this application to Art Unit 1723.

b. Telephone inquiries regarding this application should be directed to the Technology Center 1700 receptionist at ☎(703) 308-0651 or to the Examiner at ☎(703) 308-0112. Official facsimile correspondence filed before a final office action should be transmitted to ☎(703) 872-9310. Official facsimile correspondence which responds to a final office action should be transmitted to ☎(703) 872-9311.

c. Inquiries regarding application status, matching responses with applications, patent term questions, locating and retrieval of applications, incomplete office actions, requests for copies of office actions and/or references, requests to remail office actions, small/large entity status, or other administrative inquiries should be directed to the **Technology Center 1700 Customer Service Center** at ☎(703) 306-5665.

### ***Election/Restriction***

2. Claims 8-12 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

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The invention of newly submitted claims 8-12 and the invention of originally presented claims 1-2 are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process such as a process which lacks a step of providing a centrifuge with at least two opposing arms, a step of defining a flow path between concentric tube walls, or a step of forming plugs in the distal ends of the multiple arms.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, method claims 8-12 remain withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Drawings***

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 29 MAY 2001 have been approved by the Examiner.

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***Specification***

4. The abstract is acceptable.
5. The title is acceptable.
6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and M.P.E.P. § 608.01(I).

Correction of the following is required:

- a. the language added to the end of claim 3 appears to lack antecedent basis in the specification.

***Claim Rejections - 35 U.S.C. § 112***

7. Claims 3-7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3, line 13: "said outermost tube" lacks antecedent basis. Furthermore, the "outermost" designation is with respect to what reference axis, surface, or plane? Is the outermost tube the tube which extends the longest distance in the radial direction (e.g., tube 326 in Fig. 14) or is it the tube which is the largest diameter tube (i.e., the concentrically outermost tube) in the separation chamber (e.g., tube 328)? The

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confusion surrounding the recitation of "said outermost tube" thus renders the scope of the claims indefinite.

***Claim Rejections - 35 U.S.C. § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 3-5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nerad.

The patent to Nerad discloses a centrifuge comprising a housing 10 having a central body (above 13) with a top and bottom collar (the areas above and below 27); the central body defining an axis; a hollow arm 6 extending from the central body with a first end attached to the central body and a second end extending away from the central body (Figs. 1-2); the hollow arm 6 having an end cap 7 to form a chamber in the arm including tubes 22 and 23; the tube 23 being the outermost tube (i.e., the tube which extends radially outwardly from the axis of rotation to the greatest extent); the tubes defining walls; a baffle 26 attached to the central body and extending into the chamber and defining a flow path between concentric tube walls (Figs. 1-2) within the chamber; the flow path including a first exit path (within 22) for guiding lighter material out of the housing (at 27, 28) and a second exit path (within 23) for guiding heavier

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material through the housing as the solids constituents accumulate; entrance path 9 formed in the housing; the entrance path being in fluid communication with the flow path via the outermost tube 23 (as seen by the flow arrows); a frame 12, 17 supporting the housing 10 for rotation of the arm; and a bearing 14 engaging the top collar (above 27).

***Claim Rejections - 35 U.S.C. § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Nerad in view of Coleman.

Nerad discloses a drive motor 16 for providing rotational motion but does not disclose the recited ring gear. Coleman discloses a drive means for a centrifuge comprising a drive motor 29 and a ring gear 26 coupled to housing 14 and the motor 29. In view of the teachings of Nerad which suggests that any suitable means for rotating the centrifuge may be employed (Col. 2, lines 16-19), it would have been

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obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have provided the centrifuge of Nerad with a motor and ring gear drive means as disclosed by Coleman for the purpose of providing a simple and efficient means for imparting motion to the centrifuge (Col. 1, lines 18-20).

***Allowable Subject Matter***

12. Claim 7 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims. However, combining claim 7 into claim 3 would result in a claim almost equivalent to patented claim 1 in U.S. Patent No. 6,142,924 and would require consideration of a double patenting rejection of such a claim.

***Response to Amendment***

13. Applicant's arguments filed 03 OCT 2001 have been fully considered but they are not deemed to be persuasive.

Since it is not clear what is meant by the recitation of "said outermost tube" in claim 3 as explained above, the patent to Nerad is still deemed to anticipate the claims as the entrance path is clearly in fluid communication with the flow path via tube 23 which is the tube which extends radially outwardly from the axis of rotation the greatest



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distance, hence, barring any claim language to the contrary, can be termed the "outermost tube" within the scope of claim 3.

Turning to the rejection of the claims under 35 U.S.C. § 102(b), it is noted that the terminology in a pending application's claims is to be given its broadest reasonable interpretation (*In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (*Sjolund v. Musland*, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)). Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570, 7 USPQ2d 1057, 1064 (Fed. Cir.), cert. denied, 488 U.S. 892 (1988); *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of properties that are inherently possessed by the prior art reference. *Verdegaal Brothers Inc. v. Union Oil Co. of California*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim when that reference discloses each and every element set forth in the claim (*In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990));

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however, the law of anticipation does not require that the reference teach what Applicant is claiming, but only that the claims "read on" something disclosed in the reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984) (and overruled in part on another issue), *SRI Intel v. Matsushita Elec. Corp. Of Am.*, 775 F.2d 1107, 1118, 227 USPQ 577, 583 (Fed. Cir. 1985). Also, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. See *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), *cert. denied*, 116 S.Ct. 1362 (1996), quoting from *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962).

With respect to the applied prior art under 35 U.S.C. § 102(b), the examiner has demonstrated how the Nerad reference discloses each and every element set forth in the claims and how the pending claims read on the disclosure of the reference, hence the rejection is considered proper.

### **Conclusion**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Charles Cooley whose telephone number is ☎ (703) 308-0112.

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15. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is ☎ (703) 308-0651.

Dated: 10 January 2002



**Charles Cooley**  
**Primary Examiner**  
**Art Unit 1723**